Attorney Docket No.: CN01567K1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: **Neng-Yang Shih *et al.***	Examiner: **Celia C. CHANG**
Serial No.: **10/612,176**	Group Art Unit: **1625**
Filed: **07/02/2003**	Date: **August 23, 2004**
For: **NK_1 Antagonists**	

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Response to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

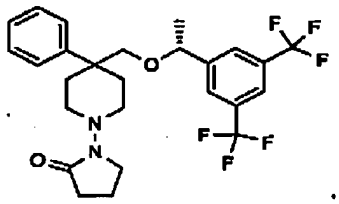
Sir:

In response to the Requirement for Election/Restriction of July 22, 2004, Applicants elect, with traverse, the invention of Group I. In addition, Applicants elect the specie of Example 56.

Remarks begin at page 2 of this paper.

Remarks

Applicants respectfully traverse the Examiner's Requirement for Restriction in the present application for the reasons stated below. However, in order to advance prosecution, Applicants elect Group I, and further elect the specie of Example 56:



The Examiner states that the inventions of Groups I and II are independent and distinct because the "core structure" in the respective groups is different, and therefore would not "belong to the same class of compounds." However, Applicants respectfully submit that restriction on this basis is not proper because the Examiner has simply *concluded* that the "core structure[s]" of the compounds of Groups I and II are different, but has not provided *reasons or examples* explaining how the core structures are different, and therefore why such structures would be recognized independent and distinct classes of compounds. (See MPEP 803, which states "Examiners **must** provide reasons and/or examples to support **conclusions**"; emphasis added). Applicants respectfully submit that the Examiner has failed to provide a proper basis for restriction, and accordingly Applicants respectfully request that the requirement be withdrawn.

Furthermore, Applicants note that many compounds have different structures, yet are recognized as belonging to the same class of compounds. For example, naphthalene and benzene both belong to the class of aromatic compounds, yet have different structures. Thus, even if the compounds of Groups I and II do, *arguendo*, have different "core structures", the Examiner has failed to show, why, based on these alleged differences, one would recognize that the compounds of Groups I and II belong to different classes. Accordingly, Applicants respectfully request that the requirement be withdrawn

In addition, in order for restriction to be proper, the Examiner must show not only that the inventions of Groups I and II are patentably distinct, but also that

examination of both groups would pose a "serious burden on the examiner" (see MPEP 803). The Examiner has failed to provide reasons indicating why examination of both Group I and Group II would pose a serious burden. Accordingly, Applicants respectfully request that the requirement be withdrawn

The Examiner also states that Groups I-II and III "per se are not coextensive" and are thus "independent and distinct". However, the Examiner has not explained why Groups I-II and III are "per se are not coextensive", but has merely concluded that they are. Furthermore, as discussed above, the Examiner has failed to provide reasons indicating why examination of both Group I-II and Group III would pose a serious burden. Accordingly, Applicants respectfully request that the requirement be withdrawn

The Examiner also states that the invention of Groups IV-VI can be practiced with "a patentably distinct product such as evidenced in CA 125:339038." Applicants note that CA 125:339038 has not been made of record in this case, and has not provided Applicants a copy of this document. Thus, the Examiner has not provided the required reasons or evidence, on the record, showing how the "product" of CA 125:339038 is **materially** different from the claimed product (MPEP 806.05(h)). Accordingly, Applicants respectfully request that the requirement be withdrawn

Finally, the Examiner states that the invention of Group VII is "unrelated to the compound per se" (presumably the compounds of Groups I and II). MPEP 806.04 and 808.01 in combination indicate that "unrelated" inventions are those which the Examiner can show "are not disclosed as capable of use together and have different modes of operation, different functions, or different effects" (MPEP 808.01, form paragraph 8.20.02). Applicants make no statement in regard to the patentable distinctness of Groups I, II, and VII. However, Applicants fail to understand how the invention of Group VII can be deemed "unrelated" to the invention of Group I, when Claims 30-35 depend from Claim 1. Applicants therefore respectfully submit that the Examiner has not made the required showing that the inventions of Groups I-II and VI are "unrelated". Accordingly, Applicants respectfully request that the requirement be withdrawn

For the reasons stated above, Applicants respectfully submit that the Requirement for Restriction is improper and request that it be withdrawn. However, should the Examiner maintain the Requirement for Restriction, Applicants have elected the product of Group I, and accordingly, any withdrawn process claims (i.e., the claims of Groups IV-V) which depend from or otherwise include the limitations of allowable product claims should be rejoined (MPEP 821.04).

Applicants note that Claim 19 (Group III) relates to a composition comprising a carrier, a serotonin reuptake inhibitor, and at least one compound of Claim 1. Applicants respectfully submit that if the invention of Group I is found allowable, the invention of Group III must necessarily also be allowable. Accordingly, Applicants request that Groups I and III be combined.

Respectfully submitted,
SCHERING-PLOUGH CORPORATION

Dated: **August 23, 2004**
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I hereby certify that this correspondence is being transmitted via facsimile addressed to Examiner Celia C. CHANG at (703) 872-9306 at the United States Patent Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 on August 23, 2004.

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Date of Signature

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